

## REMARKS

## Status of the Claims

Claims 1-27 remain pending in the application, Claims 1, 12, and 21 having been amended, but not for reasons related to the prior art. Claim 21 has been amended to correct a minor typographical error.

## Rejection of Claims under 35 U.S.C. §101

The Examiner rejected claims 1-27 under 35 USC 101 asserting that the claimed invention is directed to nonstatutory subject matter. In particular, the Examiner asserts that "in claims 1, 12, 21, 26 and 27 the applicants claim the method, system, and apparatus for including a software resource as a participant with an online chat session through messaging service but does not define within the body of claim the hardware in which the invention runs." Claims 1 and 12 are amended as set forth above to recite that the method is "computer implemented." With regard to the Examiner's rejection of Claims 21, 26, and 27, applicants respectfully disagree that these claims are directed to nonstatutory subject matter, or that the hardware in which the invention runs is not defined within the body of the claims. Claim 21 recites in subparagraph (b) "*a user computing device* coupled to the network and including a processor programmed to: . . ." (emphasis added). This subparagraph is followed by a recitation of the functions implemented by the processor. Similarly, Claim 26 recites in subparagraph (e) "*a processor* coupled to the network interface, the display, the user input device, and the memory, said processor executing the machine instructions, causing the processor to carry out a plurality of functions, including: . . ." (emphasis added). Again, this subparagraph is followed by functions implemented by the processor. Finally, Claim 27 recites in subparagraph (c) "*a processor* coupled to the network interface, and the memory, said processor executing the machine instructions, causing the processor to carry out a plurality of functions, including: . . ." (emphasis added), the following recitation provides functions implemented by the processor. Each of Claims 21, 26, and 27 define hardware within the body of the claim that are employed for carrying out the recited functionality. Therefore, applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejection of Claim 21, 26, and 27.

**Claims Rejected under 35 U.S.C. §102(e)**

The Examiner has rejected Claims 1, 3-4, 6-13, 15-17, 20-24, and 26-27 as being anticipated by Shtivelman (U.S. Patent No. 6,346,952 hereinafter referred to as “Shtivelman”). The Examiner

1 asserts that Shtivelman describes each element of applicants' claimed invention. Applicants  
2 respectfully disagree for at least the reasons discussed below.

3 In the interest of reducing the complexity of the issues for the Examiner to consider in this  
4 response, the following discussion focuses on independent Claims 1 (as amended), 12 (as  
5 amended), 21, 26, and 27. The patentability of each dependent claim is not necessarily separately  
6 addressed in detail. However, applicants' decision not to discuss the differences between the cited art  
7 and each dependent claim should not be considered as an admission that applicants concur with the  
8 Examiner's conclusion that these dependent claims are not patentable over the cited references.  
9 Similarly, applicants' decision not to discuss differences between the prior art and every claim  
10 element, or every comment made by the Examiner, should not be considered as an admission that  
11 applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed,  
12 applicants believe that all of the dependent claims patentably distinguish over the references cited.  
13 However, a specific traverse of the rejection of each dependent claim is not required, since dependent  
14 claims are patentable for at least the same reasons as the independent claims from which the  
15 dependent claims ultimately depend.

16 The Examiner first asserts that Shtivelman discloses "a method for including a software  
17 resource as a participant within an online chat session conducted through a messaging service" at  
18 column 4, lines 37-47. However, Shtivelman does not actually disclose that "a software resource" is  
19 configured "as a participant within an online chat session." Instead, the portion of Shtivelman cited  
20 by the Examiner discloses "a DNT-capable communication center operating a chat-management  
21 software," which is not even similar to what is recited by applicants' Claim 1. For example,  
22 Shtivelman teaches that his invention pertains to "auto-assisting agents participating in agent-led chat  
23 sessions by summarizing previous threads in a chat session" (Shtivelman, col. 1, lines 22-24). The  
24 Examiner next asserts that col. 11, lines 17-21 of Shtivelman discloses subparagraph (a) of applicants'  
25 Claim 1, which recites, "registering the software resource to indicate that it is available to participate  
26 in an online chat session, when said software resource is executed." However, Shtivelman does not  
27 disclose or suggest what is recited by subparagraph (a) of applicants' Claim 1. The cited portion of  
28 Shtivelman relied upon by the Examiner reads, "[i]n one embodiment, CMS software can be  
29 implemented on a shared data network wherein agents host sessions in network servers from home  
30 computers having network connection capability. Agents who logon to the network are assigned

1 initial chat sessions held in network servers." Clearly, there is no disclosure or suggestion within this  
2 cited text that even relates to "registering the software resource to indicate that it is available to  
3 participate in an online chat session, when said software resource is executed." In fact, the above  
4 cited portion of Shtivelman specifically relates to chat management software (CMS) for *human*  
5 *agents*, not to a *software resource* that is available to *participate in* a chat session.

6 Furthermore, the Examiner relies on col. 7, lines 9-13 and lines 46-60 of Shtivelman to reject  
7 subparagraph (b) of Claim 1, which recites, "enabling a user to include the software resource within a  
8 list of participants in the online chat session." However the cited portions of Shtivelman, which are  
9 reproduced below, do not disclose or suggest in any way what is recited by subparagraph (b) of  
10 applicants' Claim 1. Instead, the cited portion of Shtivelman is directed to advertising scheduled chat  
11 sessions, as should be evident from the following:

12 Scheduled chat sessions hosted by servers 47 and 49 are advertised in server 35 and may  
13 be accessed by anyone with the appropriate computer equipment, chat software and  
14 Internet connection. Such conventions are known in the art as well as are the methods of  
joining in participating in a running chat session. Shtivelman, col. 7, lines 9-13.

15 Furthermore, column 7, lines 46-60 of Shtivelman recite:

16 In practice of the present invention a plurality of scheduled chat sessions, hosted by  
17 servers 47 and 49 are ongoing at any given time within communication center 15. Such  
18 sessions are advertised to the public in such as server 35 in Internet 13. IPRTR 43 by  
19 way of CMS 45 assigns specific agents to host the sessions according to topic, skill level,  
20 and other communications-center rules. One agent may be assigned to more than one  
21 chat session depending on chat topic and versatility of agent skill. Interested persons  
22 navigating server 35 such as represented by vector 37 may access and join any one of the  
ongoing chat sessions by conventional means (clicking a chat link, etc.).

23 Each ongoing chat session may have a limit set on a number of participants allowed to  
join one session before the session is considered full as generally known in the art.

24 As will clearly be evident from the above cited portions of Shtivelman, there is no disclosure  
25 or suggestion of "enabling a user to include the *software resource* within a list of *participants in* the  
26 *online chat session*" (emphasis added), as recited by applicants' Claim 1. For at least the above  
27 reasons, applicants assert that Shtivelman does not disclose or suggest what is recited in applicants'  
28 Claim 1, and therefore does not anticipate Claim 1 or render it obvious. For this reason, Claim 1 is  
29 allowable over the cited art. However, the Examiner relies upon these same cited portions of

1 Shtivelman to reject similar subparagraphs of Claims 12, 21, and 26, which each include a *software*  
2 *resource* as a *participant*. Therefore, each of Claims 12, 21, and 26 are also allowable over the cited  
3 art, based on the same reasoning applied above in traversing the rejection of Claim 1 over  
4 Shtivelman.

5 The Examiner relies upon Shtivelman, column 7, lines 9-19, and column 11, lines 20-21 to  
6 reject Claim 27. Column 7, lines 9-13 of Shtivelman are reproduced above; lines 14-19 of column 7  
7 further recite:

8 Therefore detailed descriptions of known chat features and capabilities will not be  
9 provided here, but are noted to be available to the inventor and the skilled artisan. It is  
10 sufficient to say that all existing features found in current chat programs are supported by  
the present invention including voice chat.

11 Furthermore, column 11, lines 20-21 of Shtivelman recites "Agents who log-on to the  
12 network are assigned initial chat sessions held in network servers." Nothing in the above cited  
13 portions of Shtivelman discloses or even suggests, "registering the *software resource* within a  
14 messaging service as being available to *participate in* a messaging service session" (emphasis added),  
15 as recited by subparagraph (c)(i) of applicants' Claim 27. Therefore, Claim 27 is allowable over  
16 Shtivelman. For each of the reasons stated above, applicants assert that Claims 1, 12, 21, 26, and 27,  
17 and each of the claims that depend from them are all allowable over the cited art.

18 Claims Rejected under 35 U.S.C. § 103

19 The Examiner rejected Claims 2, 5, 14, 18, and 25 under 35 U.S.C. § 103(a) as being  
20 unpatentable over Shtivelman in view of U.S. Patent No. 6,564,261 (Gudjonsson et al). The  
21 Examiner further rejected Claim 19 over Shtivelman in view of U.S. Patent No. 6,373,853 (Yoshida).  
22 Claims 2 and 5 depend from Claim 1, Claims 14, 18, and 19 depend from Claim 12, and Claim 25  
23 depends from Claim 21. Since each dependent claim inherently includes the recitation of the  
24 independent claim from which it ultimately depends, each of the above rejected dependent claims is  
25 patentable for at least the reasons stated above for the patentability of independent Claims 1, 12,  
26 and 21. For this reason, the rejection of Claims 2, 5, 14, 18, 19, and 25 is improper, and applicants  
27 therefore request that the rejection of each of these claims be withdrawn.

28 In consideration of the remarks set forth above, all claims in the present application are  
29 patentable over the art of record. Since the application is in condition for allowance, the application  
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1 should be passed to issue without further delay. Should any questions remain, the Examiner is  
2 invited to telephone applicant's attorney at the number set forth below.  
3

4 Respectfully submitted,  
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8 Ronald M. Anderson  
9 Registration No. 28,829  
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11 RMA/PJN:elm:klp  
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13 **MAILING CERTIFICATE**

14 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed  
envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents,  
Alexandria, VA 22313-1450, on November 29, 2005.

15 Date: November 29, 2005

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